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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/510,087 02/22/00 SMITH

P EVS-P-99-017

EXAMINER

QM02/0430

Patents+TMS  
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WALLZARD  
ART UNIT

PAPER NUMBER

3751  
DATE MAILED:

04/30/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/510,087

Applicant(s)  
Smith

Examiner  
David Walczak

Art Unit  
3751



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Apr 2, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application

4a) Of the above, claim(s) 12, 13, and 20 is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-9, 11, and 14-19 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on Feb 22, 2000 is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

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## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the surface (claims 1, 15 and 17) must be shown or the feature canceled from the claims. No new matter should be entered.

### *Claim Rejections - 35 USC § 112*

2. Claims 1, 9, 15 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In regard to claims 1, 15 and 17, the recitation of the lead being "removably" attached to a surface is considered to be new matter. Further in regard to claim 15, the recitation of the lead having an end "removably" connected to the end cap is considered to be new matter. In regard to claim 9, the recitation of the clamp "removably" securing the article to the barrel is considered to be new matter. It is noted that even though the clamp has been disclosed as being screwed to the article, the specification does not disclose the screws as being removable, i.e., some anchor type screws are not removable.

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9 and 14 remain rejected under 35 U.S.C. 102(b) as being anticipated by Fischer.

In regard to claim 9, Fischer discloses a "device accessory kit" comprised of a marking device, a flat article which wraps around the marking device and a "clamp" (the stitching, in as much as the Applicant has defined the term "clamp", as stitching is used to "clamp" together articles, stitching can be considered a clamp) which "removably secures" the article to the marking device, i.e., as stitching can be removed, the stitching removably secures the article to the marking device. In regard to claim 14, there must exist some "tool" which attaches the stitching to the article.

5. Claims 15 and 16 remain rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al. (hereinafter Martin). Martin discloses an accessory kit comprised of marking device 16, an end cap 15 which is capable of fitting onto the end of a plurality of marking devices (lines 82-85) and a chain 14 connected to the end cap wherein the chain has a first end "removably" connected to the end cap and another end "removably" connected to a surface 18 remote from the end cap.

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*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-8, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of Martin. In regard to claims 1-4 and 6-8, as discussed supra, Fischer discloses a marking device covered with a sheath. Although Fischer does not disclose the use of an end cap, attention is directed to the Martin reference which, as discussed supra, discloses an end cap for a marking instrument as claimed in order to enable the marking instrument to be secured to a particular location. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include such an end cap onto the Fischer device in order to enable the device to be secured to a particular location. In regard to claims 17 and 19, the method as claimed is inherent in the usage of the device defined supra.

8. Claims 5 and 18 are U.S.C. 103(a) as being unpatentable over Fischer in view of Martin as applied to claims 1 and 17 above, and further in view of the Applicant's disclosure. Although the sheath in the Fisher reference is not disclosed as having an antibacterial substance thereon, attention is directed to page 7, lines 17 of the Applicant's disclosure, which discloses that antibacterial substances are commonly used to coat surfaces in order to render the surfaces sanitary (column 2, lines 66-67). Accordingly, it would have been obvious to one of ordinary skill in the

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art at the time the invention was made to coat the sheath in the Fischer device with an anti-bacterial coating in order to render the sheath sanitary.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of the Applicant's disclosure. As discussed supra, it would have been obvious to coat the Fischer sheath with an anti-bacterial coating.

### ***Response to Arguments***

10. Applicant's arguments filed 4/2/01 have been fully considered but they are not persuasive. The Applicant contends that Fischer does not disclose a clamping device which can be removed and reapplied, however, as discussed above in detail, the stitching in Fischer does disclose a removable clamping device. It is further noted that a clamping device which can be removed and reapplied has not been claimed. The Applicant further contends that Martin does not include a cap which can hold writing device of varying shapes, however, such a feature has not been claimed. The claims merely call for a cap which is interchangeable between a plurality of devices, which the cap in Martin is capable of doing (lines 81-85). Further, the Applicant contends that Martin does not disclose a holder that is removably attached to a surface, however, the chain in Martin is "removably" attached to element 18, which element includes a "surface". Further, the Applicant contends that the connecting lead of the present invention can be removably attached to any surface while the Martin lead cannot, however, the limitation of the lead being removably attached to any surface has not been claimed. Lastly, in response to the Applicant's argument

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that there is no suggestion to combine the Martin and Fischer references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine the references is found in the knowledge available to one of ordinary skill in the art, i.e., as it is known in the art to provide a connecting lead to a writing implement (as evidenced by Martin), one of ordinary skill in the art would readily recognize that the writing implement disclosed by Fischer can be modified to include such a lead.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Walczak whose telephone number is (703) 308-0608.

D Walczak

April 30, 2001



**DAVID J. WALCZAK**  
**PRIMARY EXAMINER**